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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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09/943,836

08/31/2001

Royce D. Jordan JR.

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01/31/2008

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EXAMINER

STRANGE, AARON N

ART UNIT

PAPER NUMBER

2153

MAIL DATE

DELIVERY MODE

01/31/2008

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

09/943,836

Applicant(s)

JORDAN, ROYCE D.

Examiner

Aaron Strange

Art Unit

2153

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED. (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 31 October 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 38-59 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 38-46 and 48-59 is/are allowed.
- 6) ☒ Claim(s) 47 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Arguments

1. Applicant's arguments, see pages 9-19, filed 10/31/07, with respect to the rejection of claims 38-58 under 35 U.S.C. § 103(a) have been fully considered and are persuasive. The rejection of those claims has been withdrawn. While all rejections based on prior art have been withdrawn, some objections/rejections remain, which have been set forth below.

Specification

2. The specification is objected to as failing to provide proper antecedent basis for the claimed subject matter. See 37 CFR 1.75(d)(1) and MPEP § 608.01(o). Correction of the following is required: The specification makes no reference to the term "tangible computer-readable storage medium", which appears in claim 48. Applicant must amend the specification to provide clear support or antecedent basis for the term, taking care to ensure that no new matter is introduced.

Claim Rejections - 35 USC § 101

3. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

4. Claim 47 is rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

5. Claim 47 recites a system claim comprising a plurality of "means for" performing various functions. The specification of the present application discloses that these functions are performed at the gateway, and claim 48 contains limitations directed to a computer readable medium containing instructions to perform the same functions. The language of the claims, when considered in combination with the language of the specification, would have suggested to one of ordinary skill in the art that the claimed "means" are intended to include software-only embodiments. Therefore, since the claim is not limited to statutory subject matter, it is non-statutory.

Allowable Subject Matter

6. Claims 38-46 and 48-59 allowed.

7. The following is an examiner's statement of reasons for allowance: The prior art of record fails to disclose or reasonably suggest, a method/system as claimed, including processing at least one electronic message based on criteria including both size and type of the electronic message and size and type of an attachment attached to the electronic message, removing one or more attachments from the electronic message based on the criteria, displaying the size and type of the one or more attachments, and

receiving instructions from the recipient for processing the attachment at a plurality of subsystems indicated by the user.

Regarding claim 49, it is noted that the limitation "a gateway ... configured to:" has been interpreted as a hardware device (i.e., a computer, ASIC, etc.) containing software that causes the gateway to perform the claimed functions or specialized hardware equivalents that perform the claimed functions. This interpretation is consistent with the specification (fig. 1, 2 & 6; pp. 6-7) as in intended to distinguish the claim from software per se and provide a structural differentiation between the claimed gateway and a general purpose computer merely capable of performing the claimed functions.

8. The reasons for allowance set forth above should not be interpreted to imply that limitations not specifically mentioned are immaterial to patentability. The specific limitations identified above have been considered in combination with the entirety of the claim in determining patentability.

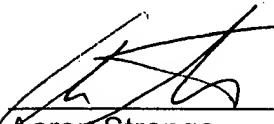
Any comments considered necessary by applicant must be submitted no later than the payment of the issue fee and, to avoid processing delays, should preferably accompany the issue fee. Such submissions should be clearly labeled "Comments on Statement of Reasons for Allowance."

Conclusion

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Aaron Strange whose telephone number is 571-272-3959. The examiner can normally be reached on M-F 8:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Glen Burgess can be reached on 571-272-3949. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



Aaron Strange
GAU 2153
1/30/08